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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,550	08/17/2005	Norimasa Ishii	16169.6	3823

22913 7590 02/06/2008

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EXAMINER	
FALASCO, LOUIS V	
ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
02/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,550	ISHII ET AL.	
	Examiner	Art Unit	
	Louis Falasco	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-13 and 16-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-13* is/are rejected.

7)☒ Claim(s) *16-21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Papers Received

1. The Amendment and Remarks filed 12/31/07 are acknowledged.

Claims

2. The claims under consideration are 1-3, 5-13 and 16-21.

Claim Rejections

Statutory Basis: The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1 to 3 and 5 to 13 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Hironao et al** (JA 2002-032909) for reasons of record.

2. Claims 1 to 3 and 5 to 13 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Saito et al** (US 2002/0127432 or 2003/0164005) for reasons of record.

Summarizing the reasons of record for the rejections, it was noted the prior art did not characterize bearing ratios for their substrates. Notwithstanding this it was shown how the same materials and manufacturing processes have

been shown in the prior art which would have reasonably been expected to produce the same substrate.

Response to arguments

3. Applicants' arguments filed 12/31/07 have been fully considered but they have not been found persuasive.

4. Applicants argue that although materials and manufacturing parameters have been shown in **Hironao et al** and **Saito et al** many factors go into producing the glass substrate for magnetic recording of the claims and so concluded it would not be the same or obvious article aspects in **Hironao et al** and **Saito et al** point away from what has been claimed.

The previously Office action pointed out in detail how the prior art taught the same materials and had the same processes for production. In this way a reasonable expectation of the same product had been established. The claiming of an unidentified property appearing inherently present does not necessarily make a claim patentable. Where claimed and prior art products have been shown to be substantially identical in structure or composition or produced by the same processes a case of anticipation or *prima facie* obviousness has been established. The burden of proof shifts to applicants. Applicants must show

prior art products do not necessarily nor inherently posses the characteristic of the claimed product. The Response points out the prior art failing to identify properties such as Bearing Height, bearing ratios, etc. However has the burden of showing they do not. To establish unobviousness applicants have a burden to come forward with evidence establishing an unobvious difference between the claimed product and the prior art[1].

(a) The prior art has been argued as different, but without specific reference to any specific differences in materials or processes and without evidence[2] contrasting the metes and bounds of rejected claims 1 to 3 and 5 to 13.See MPEP 2112.01, 2113 and 2141.2 with regard to the burden overcoming rejections based on inherency.

(b) The prior art has been argued as not including Bearing heights and bearing rations, but a *prima facie* case of obviousness has been established by through materials and processes of manufacture. Though bearing ratios and heights have not been measured in the prior art ". . . the characterization of a prior art material also does not make it novel."[3]

(c) As regards specific arguments:

(*i*) It is argued **Hironao et al** ridge heights (i.e., 3nm or less) and roughness maximum (i.e., 20-60 nm) teach away from the claimed

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[1] In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)
[2] *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ2d 1943, 1947; *In re Best*, 195 USPQ 430, 433

bearing ratios and heights, and the ridges aren't circumferential. However, applicants disclose the ridge heights within that of **Hironao et al** (2nm – 5nm at specification page -3- line 13) and the instant disclosure is silent on a roughness maximum, so there is no evidence of being different then **Hironao et al**. **Hironao et al** teaches forming texture concentrically - see ¶s [0053-54], so would reasonably be expected to be concentric.

(*ii*) It is argued **Saito et al** ('432) Ra (0.5-1.0nm) and roughness maximum differ from the instant disclosed invention; this would result in a different bearing ratio and height. However, applicants disclose the Ra as 0.35-1.0 nm (page-22 lines 14,15,25,26) within that taught by **Saito et al** ('432) and are silent as to the roughness maximum, so there is no evidence of being different then **Saito et al** ('432). It is also argued **Saito et al** ('432) has different width as evident from their 5,000 – 40,000 lines/mm line density, conversely this is within the instant 10-200 nm texture line range.

(*iii*) It is argued **Saito et al** ('005) measures atomic force microscope *5* μm^2 area differing from the instant *10* μm^2 Atomic Force Microscope area - as noted by the examiner in the previous Office actions. However applicants have not shown how this area for the observation would result in a patentably different product.

(*iv*) Applicants conclude that **Hironao et al** and **Saito et al** fail because they do not address the bearing ratios and heights. However **Hironao et al** and **Saito et al** have the same substrates materials, manufactured within the same parameters. Identifying

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[3] In re Crish 73 USPQ2d 1364, 1368 and MPEP § 2112

or characterizing prior art properties does not make these properties novel. See MPEP 2112 (I).

Objection

7. Claims 16 to 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16 to 20 have been found allowable for reasons set forth the in the pervious Office action of 7/30/08 on paragraph bridging pages 6 and 7.

CONCLUSION

The claims are 1 to 3, 5 to 13 and 16-21.

- Claims 16-21 have been objected to as are objected to as being dependent upon a rejected base claim.
- Claims 1 to 3 and 5 to 13 have been rejected.

THIS ACTION IS MADE FINAL.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached at (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LF
01/08

CAROL CHANEY
SUPERVISORY PATENT EXAMINER